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EXAMINER
ARYANPOUR, MITRA

ART UNIT	PAPER NUMBER
3711	21

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/582,556	VAN ASSELT, JAN ABRAHAM
	Examiner	Art Unit
	Mitra Aryanpour	3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 February 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-26 and 28-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7-26 and 28-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Objections

1. Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for being dependent on a canceled claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form. Claim 8 is dependent on claim 6, which was canceled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 8, 29, 30, 32, 33 and 35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is insufficient support in the disclosure for the lower guideway to be slack. The disclosure on pages 6 merely states ". . . two positions of the lower guideway are shown in figure 1, these being shown in full line and broken line" and again on page 7, " . . . upper and lower guideways 1, 2 towards the limiting position shown in broken line". There is no clear and definite support in the disclosure for the lower guideway to be "slack". A mere reference that the lower guideway is shown in two positions does not provide support for the guideway to be "slack". No reference in the original specification and/or claims was made to have the lower guideway "slack", no additional explanation has been given in the original specification and/or claims as to the relationship of the

"slack" guideway to the remainder of the apparatus, and why it would be desirable to have such a feature, and how it would differ from a taut line? Applicant asserts that this feature exists, without providing proper support for its existence in the original application as filed.

Regarding claim 8, the disclosure provides support for the lower guideway to be attached to the stable support, however, the specification does not provide support for the lower guideway to be adjustably engaged (see page 3, lines 21-24 and page 4, lines 1-3). As best seen from the drawings the lower guideway should be adjustably connected to the stable supports, but specification indicates that the lower guideway aré adjustably engaged with the ground. Therefore, it is unclear how the lower guideway is adjustably engaged with the ground? Unless the position of the stables is changed with respect to the ground!

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-5, 7-9, 11-15, 18, 19, 28, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lingbeek (3,630,521) in view of Albert (3,086,775) and Scher et al (5,713,805) or in the alternative Ring (5,460,364).

Regarding claim 1, Lingbeek shows an apparatus for use in playing and practicing ball games comprising upper and lower guideways (2), reciprocating means (4) connected to and freely moveable along the upper and lower guideways (2), and a ball (5) connected to the

reciprocating means (4); the upper and lower guideways are substantially parallel, and lie in a plane which is generally normal to the ground (see figure 1). Lingbeek as disclosed above does not show the upper guide way to be inclined. Albert shows a practice device, wherein the rate of approach of the ball (25) to the player can be adjusted by varying the slope in the line (8). The ball is attached to an inelastic line. It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have secured the upper guide way of Lingbeek in any suitable way including at an angle as shown by Albert in order to increase the rate of approach of the ball. Lingbeek as modified above additionally lacks a substantially inelastic reciprocating means. Scher et al shows a baseball practice device wherein the reciprocating means can be either made of elastic or non-elastic material (see claims 10 and 11). Ring also shows a ball batting practice apparatus, wherein the reciprocating means (30) can be fabricated from elastic (for weak hitters or younger players) or non-elastic (for strong hitters) materials (column 4, lines 4-11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted the elastic reciprocating means of Lingbeek with a substantially inelastic reciprocating means as it is claimed by Scher et al and described by Ring in order to accommodate and meet the strength of various players.

Regarding claim 2, Lingbeek as modified above shows the maximum height of the upper guideway above the ground level to be greater than the length of the reciprocating means (see figure 1).

Regarding claims 3 and 4, Lingbeek as modified above, shows the upper and lower guideways (2) are substantially parallel and are generally normal to the ground.

Regarding claim 5, Lingbeek as modified above in view of Albert, shows the upper guideway to be inclined with respect to the ground. Albert's device only shows an upper guideway, therefore, no discussion has been made with respect to the lower guideway. Official Notice is taken that varying the slope of a line in order to control the rate of approach of a ball is well known, and it would have been obvious to have inclined the upper and/or the lower guideway of Lingbeek's device in order to increase the rate of approach of the hit balls as it is also shown and taught by Albert.

Regarding claim 7, Lingbeek as modified above shows the upper and lower guideways being attached to a pole (1; see column 1, lines 40-42).

Regarding claim 8, Lingbeek as modified above shows the lower guideway to be adjustably engaged with the ground (the position of the support poles can be changed).

Regarding claim 9, Lingbeek as modified above shows the reciprocating means comprises an upstanding line (4) connected to the upper and lower guideways (2).

Regarding claims 11 and 12, Lingbeek as modified above shows the reciprocating means (4) is connected to the upper and lower guideways means (2) through a slide (3), wherein the slide is a ring (see figure 1).

Regarding claims 13-15, Lingbeek as modified above, shows the reciprocating means (4) is made of low friction material (it can be made of elastic or rubber, both of which are a form of plastic). Albert also shows the upper guide way to be made of a plastic covered line (column 1, lines 62-66); and the reciprocating means (23) to be partially covered by a plastic sleeve (30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a plastic cover for the modified device of Lingbeek such as the one described by

Albert in order to protect the guide and/or reciprocating means from damage due to repetitive use. It would have also been obvious to use this material for the guidelines and the reciprocating means in order to provide protection and to reduce cost of manufacturing.

Regarding claims 18 and 19, Lingbeek as modified above shows the ball can be connected at any point along the reciprocating line (4) using stop means (6) and the ball (5) can be of any size, shape or material desired (see column 1, lines 47 and 48).

Regarding claim 28, Lingbeek as modified above, does not show the posts (1) to have a guide rope and peg, but teaches that the stable supports can be posts, trees, poles, buildings, or any support sufficiently spaced to support the guideways (2). Albert further shows the stable support (11) to be additionally secured in place using ropes (12) and pegs (13). It would have been obvious in view of Albert to include ropes and pegs for the stable support of Lingbeek in order to add additional stability to the overall structure.

Regarding claim 34, see comments for claim 1.

6. Claims 10, 16, 17, 20-26, 29-33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lingbeek (3,630,521) in view of Albert (3,086,775) and Scher et al (5,713,805) or in the alternative Ring (5,460,364), as applied to claim 1, and further in view of Janis (4,138,107).

Regarding claim 10, Lingbeek as modified above does not show the reciprocating means to be constructed of two upstanding lines. Janis shows the reciprocating means (14) can be made of one continuous line (figure 5) or a combination of two separate lines (figure 2) connected to the ball; the reciprocating means is connected to the upper and lower guideway means through a

slide (see figures 3 and 7), wherein the slide comprises a hook (column 3, lines 10-11). It would have been obvious to make the reciprocating line of Lingbeek of two separate lines, as taught by Janis, since having two separate lines, would limit the movement of the ball along the length of the line and provide better ball control.

Regarding claims 16 and 17, Lingbeek as modified above shows the upper and lower guideways to be made of a wire. It is well known that wires are considered as being a substantially rigid material (see column 1, lines 43-45). Nevertheless, for the sake of argument Janis shows the upper and lower guideways are made of a substantially rigid material (column 1, lines 52-58), wherein the guide ways form a track and are capable of receiving a runner (see figures 1-7). Janis does not indicate whether or not the guideways are made of plastic. Plastics are well known for their rigidity and strength, and considered art recognized equivalents to wires. To substitute the plastic material of Janis for the wire in the upper and lower guideways of Lingbeek would have been an obvious functional equivalent.

Regarding claim 20, see comments for claims 1 and 10.

Regarding claim 21, see comments for claim 4.

Regarding claim 22, Lingbeek as modified above shows the upper and lower guideway comprises a string or rope (see column 1, lines 43 and 44).

Regarding claims 23 and 24, see comments for claims 13 and 14.

Regarding claim 25, see comments for claim 11.

Regarding claim 26, see comments for claim 12.

Regarding claim 29, Lingbeek as modified in view of Albert, shows the upper guideway to be inclined with respect to the ground. Albert's device only has an upper line or guideway,

therefore, no discussion has been provided with respect to a lower guideway. Official Notice is taken that the slack in a line, would provide an inelastic line the same resiliency or "slack" that an elastic line inherently posses, which in turn allows the ball to travel more freely along the guideway(s). As can be seen from Albert the ball does not need the lower guideway to be able to travel freely on the upper guideway. The addition of a lower guideway simply confines the movement of the ball and provides a more controlled practice device. Therefore, one of ordinary skill in the art would have used a slack, semi-slacked or taut lower guideway that was most readily available for the modified device of Lingbeek in order to achieve the desired end result.

Regarding claim 30, again Lingbeek does not show the one or more upstanding lines between the ball to be slack when at rest. Albert shows the line to be slack (see figure 2). It would have further been obvious to use a slack line for the one or more upstanding lines of Lingbeek, since it would allow the ball to travel more freely.

Regarding claim 31, see comments for claim 28.

Regarding claim 32, see comments for claims 1 and 30. Regarding the limitation of "at least one upstanding stable support", Lingbeek shows at least one (1).

Regarding claim 33, see comments for claim 30.

Regarding claim 35, see comments for claim 30.

Response to Arguments

7. Applicant's arguments with respect to claims 1-5, 7-26, 28-35 has been considered but are not persuasive. Regarding applicant's assertion that *the specification does indicate, and with reasonable clarity, why the lower guideway is "slack" in the initial position and how that differs*

*from a taut line, a*nd goes on to explain, that there is only one reasonable conclusion that one of ordinary skill in the art could make regarding the nature of the lower guideway as depicted by the two positions of the guideway shown on Figure 1. Upon careful review of the specification as originally filed, it is concluded that there is no indication, or any reasonable degree of clarity for the "slack" in the lower guideway. Even the drawings are not consistent (see figure 4). For the sake of argument, if indeed the solid line is assumed to be the slack in the lower guideway, then there is no slack in the lower guideway of figure 4. The only thing Applicant has clearly defined with respect to the lower guideway is that it can be generally inclined and/or parallel to the upper guideway or it can be horizontal with respect to the ground. There is no description as to how the inelastic reciprocating means travels when struck, if it can travel at all, when the lower guideway is "slack", and how much slack should be provided in the lower guideway, in order for the reciprocating means to be able to travel effectively. In the Remarks dated 25 February 2003 (page 3), hypothetical dimensions (10.5 to 15 meters) for the lower guideway have been provided. However, such is not readily apparent from the specification, and it was not presented in the application when filed.

Although it is preferred but certainly not a requirement, to use the same language in the claims as it appears in the specification, nevertheless, some suggestion needs to already exist in the specification for the claimed subject matter. For the above reasons, and the lack of support in the specification as originally filed, it is concluded that the inventor(s), at the time the application was filed, did not have possession of the claimed subject matter.

Regarding applicant's assertion that Lingbeek teaches away from inclining the upper guideway to alter the speed of the returning ball. Lingbeek is silent regarding the upper guideway

being inclined. For a reference to be "silent" does not mean it teaches away from that feature, especially if the feature is well known, and it may well indicate that the patentee thought the feature so conventional, as not to require comments. Furthermore, it cannot be concluded for the sake of convenience that a reference teaches away, because it only shows a preferred embodiment.

Regarding applicant's remarks that Lingbeek already accommodates the strength of various players, thus there is no need to substitute the elastic reciprocating means for a substantially inelastic one. As applicant has pointed out in his remarks (page 3) a plastic-coated cord possesses some inherent flexibility. The same would be true for the reciprocating means, some degree of flexibility is desirable, therefore, there is nothing unobvious about varying the degree of flexibility in the reciprocating means of Lingbeek, whether it be for accommodating various players or to simply reduce the flexibility in the reciprocating line in order to achieve better control.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703-308-3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul T Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

MA
3 May 2003

Supervisory Patent Examiner
Group 3700